REMARKS

Corrected drawing sheets have been submitted in response to the Examiner's objection.

Claims 1 through 82 remain in this application. Claims 1, 2, 4 and 12 have been amended. Claims 13 through 82 are being added and are supported by the specification.

In the Office Action, the Examiner:

ξ   Rejected Claims 1-6, and 12 under 35 U.S.C. §102(b) as being anticipated by WO Application No. 95/15522 to Jones (Jones).

ξ   Rejected Claims 7, 8 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over Jones in view of U.S. Patent No. 6,292,092 to Chow (Chow).

Claim Rejections – 35 USC §102(e)

The Examiner rejected Claims 1-6, and 12 under 35 U.S.C. §102(b) as being anticipated by WO Application No. 95/15522 to Jones (Jones).

Claim 1

Examiner rejected claim 1 as being anticipated by Jones. With regard to the limitation in claim 1 of "receiving a source file from data owners" and "creating a fingerprint for the source file by recording portions of the source file that correspond to each of the elements in the key template," the Examiner asserts that this limitation is met because "Jones discloses a data verification system wherein a user can have a file, they created, fingerprinted at a central computer." The Applicant respectfully disagrees.

To establish anticipation, the cited references must teach each and every aspect of the claimed invention, either explicitly or implicitly. Moreover, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference.

Jones discloses having a file fingerprinted at a central computer. According to

Fig. 4C, block 98 and the specification at page 11, line 34 through page 12, line 7,

the fingerprinting is performed by calculating the cyclic redundancy check (CRC)

value of the file. Jones also discloses using the size of the document for

fingerprinting. In contrast, amended Claim 1 recites "creating a fingerprint for the

source file by recording portions of the source file that correspond to each of the

elements in the key template." Calculating a CRC is not the same as "recording

portions of the source file that correspond to each of the elements in the key

template." Support for the "key template" recited in claim 1 is found in the

specification at various locations including page 8, line 28 through page 9, line 4.

The Examiner further asserts that the CRC and the file size meet the

limitation of the "template." The Applicant disagrees. The CRC and file size of Jones

are not the same as a "creating a key template comprising a plurality of elements,

wherein each element is defined by an element size, a quantity, a start position and

an initial position," as recited in amended Claim 1. A CRC performs a mathematical

calculation on a file and returns a number that is used to identify the data. This

number is often called a checksum. By comparing the checksum on a first file to

another second file's checksum, it can be determined whether or not the files are an

exact match. CRCs are mostly performed when transferring files from one location

to another in order to determine whether or not errors have occurred during the

transmission. One of the uses of the invention is to detect the unauthorized use of

copyrighted images. (Page 21, lines 9-18.) A person who downloads copyrighted

images for unauthorized distribution can easily change a few bits in the data file so

that a CRC will not detect that the downloaded and modified file is the same as the

source file it is being compared to. Similarly, just because two files are the same

size does not mean that they have the same content. For such a purpose, the CRC

and file size are not sufficient. Furthermore, when calculating a CRC on a file, there is no motivation to create " a key template comprising a plurality of elements, wherein each element is defined by an element size, a quantity, a start position and an initial position," as recited in amended Claim 1.

Thus, Applicant asserts that Jones does not disclose or suggest "creating a key template comprising a plurality of elements, wherein each element is defined by an element size, a quantity, a start position and an initial position," as recited in amended Claim 1.

In light of the above, Applicant respectfully submits that Jones fails to teach or suggest "creating a fingerprint for the source file by recording portions of the source file that correspond to each of the elements in the key template," as recited in Claim 1. Consequently, independent Claim 1 is patentable under 35 U.S.C. §102(b) and not anticipated by Jones.

Claim 2

Examiner rejected dependent claim 2 as being anticipated by Jones. Claim 2 as amended recites "branding the source file, wherein the branding is associated with indicia of ownership." With regard to this limitation, the Examiner asserts that this limitation is met because "Jones discloses that the file can be time stamped." The Applicant respectfully disagrees. A time stamp indicates a point in time when a file is created. In contrast, a brand relates to indicia of ownership. For example, a file can be branded by storing information pertaining to intellectual property rights in the data block which is subsequently embedded in the data file. (Specification, page 14, lines 23-24 and page 15, lines 3-4) Thus, Jones fails to teach or suggest "branding the source file, wherein the branding is associated with indicia of ownership" present in amended dependent Claim 2.

In light of the above, Applicant respectfully requests that the §102(b)

rejection to Claim 2 be withdrawn and an indication of allowance be made.

Claims 3-6

The Examiner also rejected the dependent claims 3-6 as being anticipated by

Jones under 35 U.S.C. §102(b). Claims 3-6 are dependent from independent Claim

1. As shown above, Jones does not disclose all elements of Claim 1. Consequently,

dependent claims 3-6 are not anticipated by Jones. In light of the above, Applicant

respectfully requests that the §102(b) rejection to Claim 2 be withdrawn and an

indication of allowance be made.

Claim 12

Examiner rejected independent Claim 12 as being anticipated by Jones.

Claim 12 recites the limitation of "receiving a source file from data owners" and

"creating a fingerprint for the source file by recording portions of the source file that

correspond to each of the elements in the template." With regard to the limitation of

"receiving a source file from data owners" and "creating a fingerprint for the source

file by recording portions of the source file that correspond to each of the elements

in the template," the Examiner asserts that this limitation is met because "Jones

discloses a data verification system wherein a user can have a file, they created,

fingerprinted at a central computer." The Applicant respectfully disagrees and has

amended claim 12 to clarify the invention.

Jones discloses having a file fingerprinted at a central computer. According to

Fig. 4C, block 98 and the specification at page 11, line 34 through page 12, line 7,

the fingerprinting is performed by calculating the cyclic redundancy check (CRC)

value of the file. Jones also discloses using the size of the document for

fingerprinting. In contrast, Claim 12 as amended recites the limitation of "creating a

fingerprint for the source file by recording portions of the source file that correspond to each of the elements in the key template."

The Examiner further asserts that the CRC and the file size meet the limitation of the "template." The Applicant disagrees. The CRC and file size of Jones are not the same as a "key template comprising a plurality of elements, wherein each element is defined by an element size, a quantity, a start position and an initial position," as recited in Claim 12. A CRC performs a mathematical calculation on a file and returns a number that is used to identify the data. This number is often called a checksum. By comparing the checksum on a first file to another second file's checksum, it can be determined whether or not the files are an exact match. CRCs are mostly performed when transferring files from one location to another in order to determine whether or not errors have occurred during the transmission. One of the uses of the invention is to detect the unauthorized use of copyrighted images. (Page 21, lines 9-18.) A person who downloads copyrighted images for unauthorized distribution can easily change a few bits in the data file so that a CRC will not detect that the downloaded and modified file is the same as the source file it is being compared to. Similarly, just because two files are the same size does not mean that they have the same content. For such a purpose, the CRC and file size are not sufficient. Furthermore, when calculating a CRC on a file, there is no motivation to create " a key template comprising a plurality of elements, wherein each element is defined by an element size, a quantity, a start position and an initial position," as recited in amended Claim 12.

In light of the above, Applicant respectfully submits that Jones fails to teach or suggest "creating a fingerprint for the source file by recording portions of the source file that correspond to each of the elements in the key template," as recited

in Claim 12. Consequently, independent Claim 12 is patentable under 35 U.S.C. §102(b) and not anticipated by Jones.

Claim Rejections – 35 USC §103(a)

The Examiner rejected Claims 7, 8, and 9-11 under 35 U.S.C. §103(a) as being unpatentable over WO Application No. 95/15522 to Jones (Jones) in view of U.S. Patent No. 6,292,092 to Chow (Chow).

Claim 7

The Examiner also rejected the dependent Claim 7 as being unpatentable under 35 USC §103(a) over Jones in view of Chow.

With respect to Jones, the Examiner has repeated his assertions regarding the limitations of Claims 1 and 12. Claim 7 is dependent from independent Claim 1. As shown above, Jones does not disclose all elements of Claim 1. Claim 7 is also dependent from dependent Claim 2. As shown above, Jones does not disclose all elements of Claim 2. Consequently, Claim 7 is patentable over Jones.

The Examiner admits that Jones does not disclose that embedded authentication information can be encrypted and embedded into the source file. The Examiner asserts that Chow discloses an image identification system wherein authentication information is encrypted and affixed (embedded) into the source image and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the authentication information of Jones in order to protect the data as taught in Chow. The Applicant respectfully disagrees.

To establish a prima facie case of obviousness, the prior art references must teach or suggest all of the claim limitations.

Chow affixes encrypted information to a source image on a personal identity instrument. The encrypted information is physically affixed to the personal identity instrument. As disclosed in Chow, column 8, lines 31-33, "The encrypted data is

printed on a carrier 19 as a matrix 20 of black and white rectangles, using a laser printer, representing the binary number." In contrast, Claim 7 recites "if the requesting user is authorized to request the branding, encrypting the data block utilizing the preassigned encryption key assigned to the user; and embedding the encrypted data block into the source file; and creating a fingerprint of the source file with the embedded data block." Neither of the cited references, taken individually or collectively, teach or suggest the limitations recited in Claim 7.

Accordingly, Applicants respectfully suggest that the §103(a) rejection to Claim 7 be withdrawn and an indication of allowance be made.

Claim 8

The Examiner also rejected the dependent Claim 8 as being unpatentable under 35 USC §103(a) over Jones in view of Chow.

With respect to Jones, the Examiner has repeated his assertions regarding the limitations of Claims 1. Claim 8 is dependent from independent Claim 1. As shown above, Jones does not disclose all elements of Claim 1. Consequently, Claim 8 is patentable over Jones.

The Examiner admits that Jones does not disclose that the fingerprint is created using the average color values for predefined portions of the source file. The Examiner asserts that Chow discloses an image identification system wherein to create the image fingerprint, certain features of the image are extracted and weighted averages are calculated, and that these features are only based on luminance (color values) components of the picture. The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made for the source file of Jones to be an image and the fingerprint calculated using the function of Chow because the weighing functions are highly non-linear and it is very difficult to create an image which would have the same averages and yet

the image contain a face or signature of a specific person as taught in Chow." The

Applicant respectfully disagrees.

Chow discloses an algorithm for extracting global features from a photograph

appearing on a personal identification instrument such as an ID card. (Col. 4, lines

23-34.) One reason for extracting global features is to account for variations in

different scanning machines that are made by different manufacturers, because it

has been found that the digitization of a picture is not a repeatable operation (Col. 6,

lines 4-10.) Global features are extracted from the entire photograph, not just from

a predefined portion of it. In contrast, Claim 8 recites "[a] process as claimed in

claim 1, wherein the data includes pixel values and a plurality of color values for

each pixel, and wherein creating a fingerprint further comprises: averaging color

values for predefined portions of the source file." The color averaging is performed

on predefined portions of a source file. This is not the same as extracting the global

features of the source file. Neither of the cited references, taken individually or

collectively, teach or suggest the limitations recited in Claim 7.

Accordingly, Applicants respectfully suggest that the §103(a) rejection to

Claim 8 be withdrawn and an indication of allowance be made.

CONCLUSION

In view of the foregoing, The Applicant believes that all of the claims are now

in condition for allowance and respectfully requests the Examiner to issue a timely

Notice of Allowance in this case. If for any reason, the Examiner believes any of the

claims are not in condition for allowance, he is encouraged to phone the undersigned

at (650) 325-4999 so that any remaining issues may be resolved.

The above changes are believed not to add new matter, as support is found in
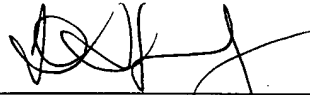
the specification as described above.

Claims 1-82 remain in this application. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Additional fees are due because the number of claims added exceeds the number of claims previously paid for. Please see Amendment Transmittal Letter for details.

Respectfully submitted,

Dennis S. Fernandez
Reg. No. 34,160

Date: 7/23/04

Address: Fernandez & Associates LLP
1047 El Camino Real, Suite 201
Menlo Park, CA 94025

Phone: (650) 325-4999
Fax: (650) 325-1203
Email: iploft@iploft.com